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Dated: April 13, 2007

Signature:

Susan Bloomfield
(Susan Bloomfield)

Docket No.: M061
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Kenneth P. Sundermeyer et al.

Application No.: 10/690,980

Confirmation No.: 4705

Filed: October 21, 2003

Art Unit: 2176

For: CONTENT-RESTRICTED EDITING

Examiner: A. L. Rutledge

APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

As required under 37 C.F.R. § 41.37(a), this Appeal Brief is being submitted in furtherance of a Notice of Appeal filed on February 15, 2007. The fees required under 37 C.F.R. § 41.20(b)(2) are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF. This Appeal Brief contains items under the following headings, as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1205.02:

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I. REAL PARTY IN INTEREST

The real party in interest for this appeal is:

Adobe Systems Incorporated

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 26 claims pending in application.

B. Current Status of Claims

1. Claims canceled: None
2. Claims withdrawn from consideration but not canceled: None
3. Claims pending: 1-26
4. Claims allowed: None
5. Claims rejected: 1-26

C. Claims On Appeal

The claims on appeal are claims 1-26.

IV. STATUS OF AMENDMENTS

A Final Office Action (hereinafter *Final Office Action*) rejecting all the claims of the present application was mailed on December 15, 2006. In response, Appellant did not file an amendment but instead filed a Notice of Appeal on February 15, 2007, which is supported by the present Appeal Brief. The claims on appeal are the same as those rejected in the *Final Office Action*, a listing of which is provided in the “Claims Appendix” section of this Appeal Brief.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The following provides a concise explanation of the subject matter defined in the independent claims involved in the appeal and separately argued means plus function claims, referring to the Specification by paragraph number and to the Drawings by reference characters where applicable. *See*, 37 C.F.R. § 41.37. However, references to passages in the Specification and Drawings does not imply that limitations from the Specification and Drawings should be read into corresponding claim elements.

According to one claimed embodiment, such as that of independent claim 1, a method to restrict editing in a tag-delimited, multi-formatted document, comprises parsing the multi-formatted document (*e.g.*, *Specification*, at ¶ [0030]; Figure 5, item 500), identifying a plurality of tags responsive to the parsing (*e.g.*, *Specification*, at ¶ [0030]; Figure 5, item 501), generating a revised document based on the multi-formatted document (*e.g.*, *Specification*, at ¶ [0030]; Figure 5, item 503), inserting one or more restriction tags into the revised document delimiting non-editable content defined by one or more of the plurality of tags (*e.g.*, *Specification*, at ¶ [0030]; Figure 5, item 504), and restricting edit functions of a page editor editing the revised document (*e.g.*, *Specification*, at ¶ [0030]; Figure 5, item 506), where the restricting is responsive to the page editor reading the one or more restriction tags (*e.g.*, *Specification*, at ¶ [0030]; Figure 5, item 507).

According to another claimed embodiment, such as that of independent claim 8, a computer program product having a computer readable medium with computer program logic recorded thereon for restricting editing of a multi-formatted document comprises code for parsing the multi-formatted document, where the each of the multiple formats is delimited in the multi-formatted document by one or more descriptive labels (*e.g.*, *Specification*, at ¶ [0030]; Figure 5, item 500), code for analyzing the one or more descriptive labels, code for generating a modified document using content of the multi-formatted document (*e.g.*, *Specification*, at ¶ [0030]; Figure 5, item 501), code for inserting a prohibition label in the modified document around each instance of non-editable content as defined by the one or more descriptive labels (*e.g.*, *Specification*, at ¶ [0030]; Figure 5, item 505), and code for prohibiting

edit functions of a document editor editing the modified document (*e.g.*, *Specification*, at ¶ [0030]; Figure 5, item 506), where the code for prohibiting is executed responsive to the prohibition labels (*e.g.*, *Specification*, at ¶ [0030]; Figure 5, item 507).

According to yet another claimed embodiment, such as that of independent claim 15, a method to restrict editing of a Web document comprises parsing the Web document (*e.g.*, *Specification*, at ¶ [0030]; Figure 5, item 500), analyzing a plurality of markup tags within the Web document (*e.g.*, *Specification*, at ¶ [0030]; Figure 5, item 501), generating a substitute Web document with content of the Web document (*e.g.*, *Specification*, at ¶ [0030]; Figure 5, item 503), inserting one or more restriction markup tags in the substitute Web document demarcating non-editable content as defined by one or more of the plurality of markup tags (*e.g.*, *Specification*, at ¶ [0030]; Figure 5, item 505), and restricting edit functions of a Web editor editing the substitute Web document (*e.g.*, *Specification*, at ¶ [0030]; Figure 5, item 506), where the restricting is responsive to the one or more restriction markup tags (*e.g.*, *Specification*, at ¶ [0030]; Figure 5, item 507).

According to still another claimed embodiment, such as that of independent claim 22, a system for preserving design elements of a Web page during content editing comprises a Web development environment having a parsing engine for analyzing a plurality of Web page markup tags (*e.g.*, *Specification*, at ¶¶ [0024] and [0025]; Figure 2, item 201), a list of restriction tags for insertion around the design elements, as defined by one or more of the plurality of Web page markup tags (*e.g.*, *Specification*, at ¶¶ [0024] and [0025]; Figure 2, item 203), and a page editor having a plurality of deselectable editing functions, where the deselection is responsive to the restriction tags (*e.g.*, *Specification*, at ¶¶ [0024] and [0025]; Figure 2, item 206).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- A. Claims 1-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2004/0177321 (*Brown*) in view of Dreamweaver TechNote 16416, “How to make an inherited region uneditable” (*Dreamweaver*);
- B. Claims 22-24, and 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,061,697 (*Nakao*) in view of *Brown*; and
- C. Claim 25 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Nakao* in view of *Brown*, and further in view of U.S. Patent No. 5,752,643 (*Judson*).

VII. ARGUMENT

Appellant respectfully traverses the outstanding rejections of the pending claims, and requests that the Board overturn the outstanding rejections in light of the remarks contained herein. The claims do not stand or fall together. In fact, Appellant presents separate arguments for various independent and dependent claims. Each of these arguments is presented with separate headings and sub-headings, as required by 37 C.F.R. § 41.37(c)(1)(vii).

A. Rejections Under 35 U.S.C. § 103(a) over *Brown* in view of *Dreamweaver*

Claims 1-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Brown* in view of *Dreamweaver*. *Final Office Action*, at p. 2. Appellant traverses the rejection and asserts that the claims are allowable, at least, for the reasons stated below.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the references' teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Appellant asserts that the rejection does not satisfy the basic criteria.

1. Lack of All Claimed Elements

a. Independent Claim 1 and Dependent Claims 2, 3, 5, and 6

Claim 1 recites, in part, "inserting one or more restriction tags into said revised document delimiting non-editable content defined by one or more of said plurality of tags" Appellant respectfully asserts that neither *Brown* nor *Dreamweaver*, taken alone or in combination, teach or suggest this claimed element.

Appellant has repeatedly pointed out that *Brown* does not teach or suggest inserting restriction tags into a revised document. *See, e.g., Amendment Accompanying Request for*

Continued Examination, at p. 10 (filed April 27, 2006); *Amendment*, at p. 8 (filed October 4, 2006). To the contrary, *Brown* teaches the use of two separate files—*i.e.*, a bounding file and an XML file. *Brown*, at ¶¶ [0060] and [0094]. According to *Brown*, the bounding file contains all editing restrictions to be applied to the XML file. *Id.* The Examiner now seems to agree with this analysis. *Final Office Action*, at p. 15 (“***the bounding file itself is not edited*** by the page editor reading the restriction tags. ***Rather, the bounding file*** disclosed by [*Brown*] ***contains restriction tags*** for *used* [sic] by the page editor ***for editing another document.***” (emphasis modified)).

Dreamweaver does not teach or suggest inserting restriction tags into a revised document either. The Examiner has incorrectly stated that *Dreamweaver* “teaches the use of nested templates with editable and non-editable regions delimited by tags that are inserted ***into a revised document . . .***” *Final Office Action*, at p. 15 (emphasis added). However, *Dreamweaver* only discloses placing a template code into a nested template, and not into an instance of the nested template—*i.e.*, a revised document. *Dreamweaver*, at p. 1 (“[i]f a developer adds a new editable region while in the nested template, ***the original editable region which contains the new editable region will be locked in instances of the nested template.***” (emphasis added)). In fact, *Dreamweaver* instructs developers to:

6. ***Within the nested template***, locate in the code the editable region from the base template you wish to lock . . . [and]

7. ***Add the following [template] code*** to the editable region [of the nested template]

Dreamweaver, at p. (emphasis added). Therefore, similar to *Brown*, *Dreamweaver*’s editing restrictions are inserted into a separate nested template file, and not into an instance of the template—*i.e.*, a revised document, as claimed.

In response to these arguments, the Examiner contends that both *Brown*’s “bounding file” and *Dreamweaver*’s “nested template file” meet the claimed revised document because “[d]uring patent examination the pending claims must be interpreted as broadly as their terms reasonably allow” *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989), *cited in*

Final Office Action, at p. 16 (emphasis added). First, the Examiner's position is contradictory insofar as the Examiner has previously expressly admitted that *Brown* does not teach or suggest inserting restriction tags into a revised document. *Final Office Action*, at p. 15. Furthermore, the Examiner seems to have improperly dissected the claimed invention into discrete elements and evaluated those elements in isolation, when instead the claim as a whole should have been considered. See, e.g., *Diamond v. Diehr*, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981).

The Examiner's interpretation of *Dreamweaver*'s nested template as meeting the claimed revised document is entirely inconsistent with the other elements recited in claim 1. For example, claim 1 also recites "restricting edit functions of a page editor editing said revised document." Thus, according to claim 1, editing restrictions are invoked with respect to a document where restriction tags are actually inserted—i.e., the revised document. In *Dreamweaver*, however, template codes are inserted into a nested template and editing restrictions are invoked with respect to an instance of the nested template (an entirely separate document). *Dreamweaver*, at pp. 2 and 3. Thus, the Examiner interpretation of *Dreamweaver*'s nested template as meeting the claimed revised document is unreasonable and incompatible with other elements recited in the claim.

In sum, neither *Brown* nor *Dreamweaver* teaches or suggests all the elements of claim 1. Consequently, the combination of *Brown* and *Dreamweaver*, even if proper, fails to teach or suggest all of the elements of claim 1. Dependent claims 2, 3, 5, and 6 depend from claim 1, thus inheriting all the elements of that base claim. Consequently, the combination of *Brown* with *Dreamweaver*, even if proper, also fails to teach or suggest all of the elements of dependent claims 2, 3, 5, and 6. Accordingly, Appellant respectfully requests that the Board overturn the 35 U.S.C. § 103(a) rejection of record with respect to claims 1-3, 5, and 6.

b. Dependent Claim 4

Dependent claim 4 depends from independent claim 1, and thus inherits all the elements of that base claim. As noted above, the combination of *Brown* and *Dreamweaver*, even if proper, fails to teach or suggest all of the elements of claim 1. Consequently, the combination of *Brown*

with *Dreamweaver*, even if proper, also fails to teach or suggest all of the elements of dependent claim 4. Moreover, claim 4 itself recites elements not taught or suggested by the combination of record.

For example, claim 4 recites “setting a restriction flag in said revised document to activate edit restriction.” The Examiner states that *Brown* discloses this feature “by designating a tag editable or non-editable . . .” *Final Office Action*, at p. 4. In response, Appellant asserts that the “flag” of *Brown* is not set “in said revised document,” as required by the claim. Instead, *Brown*’s flag is set in its bounding file. *Brown*, at ¶¶ [0060] and [0094]. The Examiner does not rely upon *Dreamweaver* as teaching or suggesting this element, and Appellant respectfully asserts that it does not. Therefore, the combination of *Brown* with *Dreamweaver*, even if proper, fails to teach or suggest all of the elements of dependent claim 4. Accordingly, Appellant respectfully requests that the Board overturn the 35 U.S.C. § 103(a) rejection of record with respect to claim 4.

c. Dependent Claim 7

Dependent claim 7 depends from independent claim 1, and thus inherits all the elements of that base claim. As noted above, the combination of *Brown* and *Dreamweaver*, even if proper, fails to teach or suggest all of the elements of claim 1. Consequently, the combination of *Brown* with *Dreamweaver*, even if proper, also fails to teach or suggest all of the elements of dependent claim 7. Moreover, claim 7 itself recites elements not taught or suggested by the combination of record.

For example, claim 7 recites “stripping out said one or more restriction tags when said page editor writes said edited multi-formatted document for presentation.” The Examiner admits that *Brown* does not teach or suggest this feature and states that *Dreamweaver* discloses such feature, but fails to specifically identify any portion of that reference that describes it. *See Final Office Action*, at p. 7. Appellant has been unable to find any portion of *Dreamweaver* that teaches or suggests stripping out a restriction tag when a page editor writes an edited multi-formatted document for presentation, as required by the claim. Therefore, the combination of

Brown with *Dreamweaver*, even if proper, fails to teach or suggest all of the elements of dependent claim 7. Accordingly, Appellant respectfully requests that the Board overturn the 35 U.S.C. § 103(a) rejection of record with respect to claim 7.

d. Independent Claim 8 and Dependent Claims 9, 10, 12, and 13

Claim 8 recites, in part, “code for inserting a prohibition label in said modified document around each instance of non-editable content as defined by said one or more descriptive labels” Appellant respectfully asserts that neither *Brown* nor *Dreamweaver*, taken alone or in combination, teach or suggest this claimed element.

Appellant has repeatedly pointed out that *Brown* does not teach or suggest inserting prohibition labels into a modified document. *See, e.g., Amendment Accompanying Request for Continued Examination*, at p. 10 (filed April 27, 2006); *Amendment*, at p. 8 (filed October 4, 2006). To the contrary, *Brown* teaches the use of two separate files—*i.e.*, a bounding file and an XML file. *Brown*, at ¶¶ [0060] and [0094]. According to *Brown*, the bounding file contains all editing restrictions to be applied to the XML file. *Id.* The Examiner now seems to agree with this analysis. *Final Office Action*, at p. 6 (“***the bounding file itself is not edited*** by the page editor reading the restriction tags. ***Rather, the bounding file*** disclosed by [*Brown*] ***contains restriction tags*** for ***used*** [sic] by the page editor ***for editing another document.***” (emphasis modified)).

Dreamweaver does not teach or suggest inserting prohibition labels into a modified document either. The Examiner has incorrectly stated that *Dreamweaver* “teaches the use of nested templates with editable and non-editable regions delimited by tags that are inserted ***into a revised document . . .***” *Final Office Action*, at p. 6 (emphasis added). However, *Dreamweaver* only discloses placing a template code into a nested template, and not into an instance of the nested template—*i.e.*, a modified document. *Dreamweaver*, at p. 1 (“[i]f a developer adds a new editable region while in the nested template, ***the original editable region which contains the new editable region will be locked in instances of the nested template.***” (emphasis added)). In fact, *Dreamweaver* instructs developers to:

6. *Within the nested template*, locate in the code the editable region from the base template you wish to lock . . . [and]

7. *Add the following [template] code* to the editable region [of the nested template]

Dreamweaver, at p. (emphasis added). Therefore, similar to *Brown*, *Dreamweaver*'s editing restrictions are inserted into a separate nested template file, and not into an instance of the template—*i.e.*, a modified document, as claimed.

In response to these arguments, the Examiner contends that both *Brown*'s "bounding file" and *Dreamweaver*'s "nested template file" meet the claimed modified document because "[d]uring patent examination the pending claims must be interpreted as broadly as their terms reasonably allow" *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989), *cited in Final Office Action*, at p. 16 (emphasis added). First, the Examiner's position is contradictory insofar as the Examiner has previously expressly admitted that *Brown* does not teach or suggest inserting prohibition labels into a revised document. *Final Office Action*, at p. 6. Furthermore, the Examiner seems to have improperly dissected the claimed invention into discrete elements and evaluated those elements in isolation, when instead the claim as a whole should have been considered. *See, e.g., Diamond v. Diehr*, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981).

The Examiner's interpretation of *Dreamweaver*'s nested template as meeting the claimed modified document is entirely inconsistent with the other elements recited in claim 8. For example, claim 8 also recites "code for prohibiting edit functions of a document editor editing said modified document, wherein said code for prohibiting is executed responsive to said prohibition labels." Thus, according to claim 8, editing prohibitions are invoked with respect to a document where prohibition labels are actually inserted—*i.e.*, the modified document. In *Dreamweaver*, however, template codes are inserted into a nested template and editing restrictions are invoked with respect to an instance of the nested template (an entirely separate document). *Dreamweaver*, at pp. 2 and 3. Thus, the Examiner interpretation of *Dreamweaver*'s

nested template as meeting the claimed modified document is unreasonable and incompatible with other elements recited in the claim.

In sum, neither *Brown* nor *Dreamweaver* teaches or suggests all the elements of claim 8. Consequently, the combination of *Brown* and *Dreamweaver*, even if proper, fails to teach or suggest all of the elements of claim 8. Dependent claims 9, 10, 12, and 13 depend from claim 8, thus inheriting all the elements of that base claim. Consequently, the combination of *Brown* with *Dreamweaver*, even if proper, also fails to teach or suggest all of the elements of dependent claims 9, 10, 12, and 13. Accordingly, Appellant respectfully requests that the Board overturn the 35 U.S.C. § 103(a) rejection of record with respect to claims 8-10, 12, and 13.

e. Dependent Claim 11

Dependent claim 11 depends from independent claim 8, and thus inherits all the elements of that base claim. As noted above, the combination of *Brown* and *Dreamweaver*, even if proper, fails to teach or suggest all of the elements of claim 8. Consequently, the combination of *Brown* with *Dreamweaver*, even if proper, also fails to teach or suggest all of the elements of dependent claim 11. Moreover, claim 11 itself recites elements not taught or suggested by the combination of record.

For example, claim 11 recites “code for setting a restriction feature flag in said modified document to activate restricted editing.” The Examiner states that *Brown* discloses this feature “by designating a tag editable or non-editable” *Final Office Action*, at pp. 4 and 8. In response, Appellant asserts that the “flag” of *Brown* is not set “in said modified document,” as required by the claim. Instead, *Brown*’s flag is set in its bounding file. *Brown*, at ¶¶ [0060] and [0094]. The Examiner does not rely upon *Dreamweaver* as teaching or suggesting this element, and Appellant respectfully asserts that it does not. Therefore, the combination of *Brown* with *Dreamweaver*, even if proper, fails to teach or suggest all of the elements of dependent claim 11. Accordingly, Appellant respectfully requests that the Board overturn the 35 U.S.C. § 103(a) rejection of record with respect to claim 11.

f. Dependent Claim 14

Dependent claim 14 depends from independent claim 8, and thus inherits all the elements of that base claim. As noted above, the combination of *Brown* and *Dreamweaver*, even if proper, fails to teach or suggest all of the elements of claim 8. Consequently, the combination of *Brown* with *Dreamweaver*, even if proper, also fails to teach or suggest all of the elements of dependent claim 14. Moreover, claim 14 itself recites elements not taught or suggested by the combination of record.

For example, claim 14 recites “code for removing said prohibition tags prior to saving said modified multi-formatted document for presentation.” The Examiner admits that *Brown* does not teach or suggest this feature and states that *Dreamweaver* discloses such feature, but fails to specifically identify any portion of that reference that describes it. *See Final Office Action*, at pp. 7 and 8. Appellant has been unable to find any portion of *Dreamweaver* that teaches or suggests code for removing prohibition tags prior to saving a modified multi-formatted document for presentation, as required by the claim. Therefore, the combination of *Brown* with *Dreamweaver*, even if proper, fails to teach or suggest all of the elements of dependent claim 14. Accordingly, Appellant respectfully requests that the Board overturn the 35 U.S.C. § 103(a) rejection of record with respect to claim 14.

g. Independent Claim 15 and Dependent Claims 16, 17, 19, and 20

Claim 15 recites, in part, “inserting one or more restriction markup tags in said substitute Web document demarcating non-editable content as defined by one or more of said plurality of markup tags” Appellant respectfully asserts that neither *Brown* nor *Dreamweaver*, taken alone or in combination, teach or suggest this claimed element.

Appellant has repeatedly pointed out that *Brown* does not teach or suggest inserting restriction markup tags into a substitute Web document. *See, e.g., Amendment Accompanying Request for Continued Examination*, at p. 10 (filed April 27, 2006); *Amendment*, at p. 8 (filed October 4, 2006). To the contrary, *Brown* teaches the use of two separate files—*i.e.*, a bounding file and an XML file. *Brown*, at ¶¶ [0060] and [0094]. According to *Brown*, the bounding file

contains all editing restrictions to be applied to the XML file. *Id.* The Examiner now seems to agree with this analysis. *Final Office Action*, at p. 9 (“**the bounding file itself is not edited** by the page editor reading the restriction tags. **Rather, the bounding file** disclosed by [Brown] **contains restriction tags** for *used* [sic] by the page editor **for editing another document.**” (emphasis modified)).

Dreamweaver does not teach or suggest inserting restriction markup tags into a substitute Web document either. The Examiner has incorrectly stated that *Dreamweaver* “teaches the use of nested templates with editable and non-editable regions delimited by tags that are inserted *into a revised document . . .*” *Final Office Action*, at p. 9 (emphasis added). However, *Dreamweaver* only discloses placing a template code into a nested template, and not into an instance of the nested template—*i.e.*, a modified document. *Dreamweaver*, at p. 1 (“[i]f a developer adds a new editable region while in the nested template, **the original editable region which contains the new editable region will be locked in instances of the nested template.**” (emphasis added)). In fact, *Dreamweaver* instructs developers to:

6. **Within the nested template**, locate in the code the editable region from the base template you wish to lock . . . [and]

7. **Add the following [template] code** to the editable region [of the nested template]

Dreamweaver, at p. (emphasis added). Therefore, similar to *Brown*, *Dreamweaver*’s editing restrictions are inserted into a separate nested template file, and not into an instance of the template—*i.e.*, a modified document, as claimed.

In response to these arguments, the Examiner contends that both *Brown*’s “bounding file” and *Dreamweaver*’s “nested template file” meet the claimed substitute Web document because “[d]uring patent examination the pending claims must be interpreted as broadly as their terms reasonably allow” *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989), *cited in Final Office Action*, at p. 16 (emphasis added). First, the Examiner’s position is contradictory insofar as the Examiner has previously expressly admitted that *Brown* does not teach or suggest inserting restriction markup tags into a substitute Web document. *Final Office*

Action, at p. 6. Furthermore, the Examiner seems to have improperly dissected the claimed invention into discrete elements and evaluated those elements in isolation, when instead the claim as a whole should have been considered. *See, e.g., Diamond v. Diehr*, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981).

The Examiner's interpretation of *Dreamweaver*'s nested template as meeting the claimed substitute Web document is entirely inconsistent with the other elements recited in claim 15. For example, claim 15 also recites "restricting edit functions of a Web editor editing said substitute Web document, wherein said restricting is responsive to said one or more restriction markup tags." Thus, according to claim 15, editing restrictions are invoked with respect to a document where restriction markup tags are actually inserted—*i.e.*, the substitute Web document. In *Dreamweaver*, however, template codes are inserted into a nested template and editing restrictions are invoked with respect to an instance of the nested template (an entirely separate document). *Dreamweaver*, at pp. 2 and 3. Thus, the Examiner interpretation of *Dreamweaver*'s nested template as meeting the claimed substitute Web document is unreasonable and incompatible with other elements recited in the claim.

In sum, neither *Brown* nor *Dreamweaver* teaches or suggests all the elements of claim 15. Consequently, the combination of *Brown* and *Dreamweaver*, even if proper, fails to teach or suggest all of the elements of claim 15. Dependent claims 16, 17, 19, and 20 depend from claim 15, thus inheriting all the elements of that base claim. Consequently, the combination of *Brown* with *Dreamweaver*, even if proper, also fails to teach or suggest all of the elements of dependent claims 16-21. Accordingly, Appellant respectfully requests that the Board overturn the 35 U.S.C. § 103(a) rejection of record with respect to claims 15-17, 19, and 20.

h. Dependent Claim 18

Dependent claim 18 depends from independent claim 15, and thus inherits all the elements of that base claim. As noted above, the combination of *Brown* and *Dreamweaver*, even if proper, fails to teach or suggest all of the elements of claim 15. Consequently, the combination of *Brown* with *Dreamweaver*, even if proper, also fails to teach or suggest all of the

elements of dependent claim 18. Moreover, claim 18 itself recites elements not taught or suggested by the combination of record.

For example, claim 18 recites “setting a flag in said substitute Web document indicating activation of said restricted editing.” The Examiner states that *Brown* discloses this feature “by designating a tag editable or non-editable” *Final Office Action*, at pp. 4 and 10. In response, Appellant asserts that the “flag” of *Brown* is not set “in said substitute Web document,” as required by the claim. Instead, *Brown*’s flag is set in its bounding file. *Brown*, at ¶¶ [0060] and [0094]. The Examiner does not rely upon *Dreamweaver* as teaching or suggesting this element, and Appellant respectfully asserts that it does not. Therefore, the combination of *Brown* with *Dreamweaver*, even if proper, fails to teach or suggest all of the elements of dependent claim 18. Accordingly, Appellant respectfully requests that the Board overturn the 35 U.S.C. § 103(a) rejection of record with respect to claim 18.

i. Dependent Claim 21

Dependent claim 21 depends from independent claim 15, and thus inherits all the elements of that base claim. As noted above, the combination of *Brown* and *Dreamweaver*, even if proper, fails to teach or suggest all of the elements of claim 15. Consequently, the combination of *Brown* with *Dreamweaver*, even if proper, also fails to teach or suggest all of the elements of dependent claim 21. Moreover, claim 21 itself recites elements not taught or suggested by the combination of record.

For example, claim 21 recites “removing said one or more restriction markup tags responsive to a user completing edits.” The Examiner admits that *Brown* does not teach or suggest this feature and states that *Dreamweaver* discloses such feature, but fails to specifically identify any portion of that reference that describes it. *See Final Office Action*, at pp. 7 and 10. Appellant has been unable to find any portion of *Dreamweaver* that teaches or suggests removing one or more restriction markup tags responsive to a user completing edits, as required by the claim. Therefore, the combination of *Brown* with *Dreamweaver*, even if proper, fails to teach or suggest all of the elements of dependent claim 21. Accordingly, Appellant respectfully

requests that the Board overturn the 35 U.S.C. § 103(a) rejection of record with respect to claim 21.

2. Lack of Motivation

Claims 1-21 are also allowable because there is no suggestion or motivation to combine the “meta editor for structured documents” described in *Brown* with the “method for making an inherited editable region uneditable” of *Dreamweaver*. In support for the combination of *Dreamweaver* with *Brown*, the Examiner has stated that:

[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to combine the templates with editable regions taught by Dreamweaver with the XML bounding DTD with restriction tags taught by Brown, so that the editing GUI would have functionality to control and restrict editing both of HTML (Dreamweaver) and XML (Brown), and so that the user would have the benefit of a simpler way to edit XML files and the application developer would have control over user actions while editing the files”

Final Office Action, at p. 4. However, *Brown* already provides “a simpler way to edit XML files and the application developer would have control over user actions while editing the files.” *See Brown*, at Abstract. Thus, there would be no discernable “benefit” in the proposed combination.

In fact, the Examiner’s additional statement of motivation only restates the “need” that *Brown* recognizes and attempts to address. *Id.* at p. 18 *citing Brown*, at ¶ [0018]. At a maximum, this may be a statement of a why *Brown* was motivated to come up with its own invention, but it is certainly not an explanation of why a person of ordinary skill in the art would be motivated to combine *Brown* with *Dreamweaver*. Again, adding *Dreamweaver* to *Brown* for the purposes put forth by the Examiner would be superfluous, and thus there would be no benefit in the proposed combination.

In addition, Appellant respectfully asserts that there is no indication in *Brown* of a need to control and restrict HTML documents. Neither is there any indication in *Dreamweaver* of a need to control and restrict XML documents. The mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the

combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990), *cited in* M.P.E.P. § 2143.01. In this case, the Examiner is merely stating that *Dreamweaver*'s HTML editor can be combined with *Brown*'s XML editor. However, neither the prior art nor the knowledge available to a person of ordinary skill in the art suggests the desirability of combining *Brown* with *Dreamweaver*.

Accordingly, Appellant respectfully requests that the Board overturn the 35 U.S.C. § 103(a) rejection of record with respect to claims 1-21.

B. Rejections Under 35 U.S.C. § 103(a) Over *Nakao* in view of *Brown*

Claims 22-24 and 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Nakao* in view of *Brown*. *Final Office Action*, at p. 11. Appellant traverses the rejection and asserts that the claims are allowable, at least, for the reasons stated below.

1. Lack of All Claimed Elements

a. Claims 22-24 and 26

Claim 22 requires "a parsing engine for analyzing a plurality of Web page markup tags" The Examiner relies solely upon *Nakao* as meeting this element. *Office Action*, at p. 9. However, Appellant respectfully asserts that the term "document elements," as used by *Nakao*, does not refer to "tags." Rather, several passages of *Nakao* describe "document elements" as portions of a document that are subject to being edited. For example, *Nakao* discloses that:

[t]he conventional SGML document managing apparatus uses the check-out/check-in system of *document elements*. It checks out a *document element* according to the request for editing from a worker, and allows the worker to update only the portion in lower hierarchical levels than the checked-out element. When the portion is checked in, it examines the conformance to the DTD of the entire document to maintain the consistency of the document (this operation is referred to as SGML parsing).

Nakao, at col. 2, lns. 20-29 (emphasis added). Thus, although *Nakao* may teach assigning an instance identifier to a document element, it does not meet the step of "identifying a plurality of Web page markup tags," as recited in claim 22, because a "document element," as defined and

used in *Nakao*, is not a “markup tag.” Appellant respectfully reminds the Examiner that *Nakao* was entitled to be his own lexicographer. *See* M.P.E.P. § 2111.01. Because a definition was provided by *Nakao* for the term “document element,” that definition controls interpretation of that term. *Id.*

The Examiner has previously contended that “[i]t was notoriously well known in the art at the time of the invention that a SGML element was also known as a ‘tag.’” *See* Final Office Action, page 11 (mailed May 5, 2006). However, it is widely known in the art that “elements” (as used by *Nakao*) are not “tags.” In fact, the difference between tags and elements is basic:

[b]ecause this *basic concept* is so important to understand, I think it bears repeating: *tags are the letters and numbers between the angle brackets, whereas elements are tags and anything between the opening and closing tags.*

John Duckett, *Beginning Web Programming with HTML, XHTML, and CSS 6* (Wiley Publishing, Inc. 2004) (emphasis added). Therefore, it is notoriously well-known in the art that an element is not the same thing as a tag. Moreover, even assuming that *Nakao*’s document element may contain a plurality of tags, identifying a document element is not the same as identifying tags within that document element. Appellant has been unable to find any disclosure in *Brown* that teaches or suggests the aforementioned feature, and the Examiner has not shown otherwise.

Claim 22 also recites “a list of restriction tags for insertion around said design elements, as defined by one or more of said plurality of Web page markup tags” The Examiner has previously conceded that *Nakao* did not teach or suggest inserting restriction tags. *See* Final Office Action mailed on May 5, 2006, at p. 3. In the current *Final Office Action*, the Examiner now states that *Nakao* meets this feature. *Final Office Action*, at p. 18. However, Appellant has still been unable to find any reference in cited passage of *Nakao* that teaches or suggests this features. *See Nakao*, at col. 9, lns. 1-45.

Claim 22 further recites “a plurality of deselectable editing functions, wherein said deselection is responsive to said restriction tags.” The Examiner relies upon *Brown* as teaching

or suggesting the aforementioned step. *Final Office Action*, at p. 11. However, at the passage cited by the Examiner, *Brown* only discloses a meta editor that allows a developer to select an element in a bounding file to be hidden or non-editable when it has a particular value. *Brown* at ¶ [0108]. Therefore, while *Brown*'s restrictions may be responsive to a developer's selection, they are not responsive to the reading of a restriction tag. Moreover, as noted above, because *Brown*'s bounding file is not a revised document, *Brown* does not restrict editing by reading tags which are placed in a revised document, as claimed.

Therefore, the combination of *Nakao* and *Brown*, even if proper, does not teach or suggest every element of claim 22. Dependent claims 23, 24, and 26 depend either directly or indirectly from claim 22, thus inheriting all the elements of that independent claim. Consequently, the combination of *Nakao* and *Brown*, even if proper, also fails to teach or suggest all of the elements of dependent claims 23, 24, and 26. Accordingly, Appellant respectfully requests that the Board overturn the 35 U.S.C. § 103(a) rejection of record with respect to claims 22-24 and 26.

2. Lack of Motivation

Appellant further asserts that, in addition to the fact that the combination of *Brown* with *Nakao* does not teach or even suggest all of the claimed elements, there is no suggestion or motivation to combine these references. The Examiner states that:

[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to apply Brown to Nakao, so that the user would have the benefit of techniques that enable application developers to have some control over what users can do when editing a structured document file

Final Office Action, at p. 12. However, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art or its teachings also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990), cited in M.P.E.P. § 2143.01. Furthermore, the language of the recited motivation is circular in nature, stating that it is obvious to make the modification because it is obvious to achieve the

result—*i.e.*, “it would have been obvious to combine *Brown* with *Nakao* in order to have features of *Brown* combined with *Nakao*’s.” Such language is merely a statement that the references can be combined and does not state any desirability for making the combination. Neither the prior art nor the knowledge available to a person of ordinary skill in the art at the time the invention was made suggest the desirability of the combination, and Appellant asserts that there is no suggestion or motivation to combine *Brown* with *Nakao*. Therefore, the Examiner has not established a *prima facie* case of obviousness under 35 U.S.C. § 103(a). *See* M.P.E.P. § 2143. Moreover, it seems that the Examiner may be relying on impermissible hindsight in order to piece together the elements of the claims based on knowledge gleaned from Appellants’ disclosure. *See* M.P.E.P. § 2145(X)(A). Accordingly, Appellant respectfully requests that the Board overturn the 35 U.S.C. § 103(a) rejection of record with respect to claims 22-24 and 26.

C. Rejection Under 35 U.S.C. § 103(a) Over *Nakao* in view of *Brown*, and further in view of *Judson*

Claim 25 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Nakao* in view of *Brown*, and further in view of *Judson*. *Final Office Action*, at p. 13. Appellant traverses the rejection and asserts that the claims are allowable, at least, for the reasons stated below.

1. Lack of All Claimed Elements

The combination of *Nakao* and *Brown* fails to teach or suggest several features required by independent claim 22. For example, the combination of *Nakao* and *Brown* fail to teach or suggest “a plurality of deselectable editing functions, wherein said deselection is responsive to said restriction tags,” “a list of restriction tags for insertion around said design elements, as defined by one or more of said plurality of Web page markup tags,” and “a parsing engine for analyzing a plurality of Web page markup tags.” The Examiner does not rely upon *Judson* as teaching or suggesting these features, and Appellant asserts that *Judson* does not teach or suggest the above-referenced features. Therefore, the combination of *Nakao*, *Brown*, and *Judson* fails to teach or suggest all of the elements of independent claim 22. Dependent claim 25 depends from claim 22, and thus inherit all the elements of that independent claim. Consequently, the

combination of *Nakao*, *Brown*, and *Judson*, even if proper, also fails to teach or suggest all of the elements of dependent claim 25. Accordingly, Appellant respectfully requests that the Board overturn the 35 U.S.C. § 103(a) rejection of record with respect to claim 25.

2. Lack of Motivation

Appellant also asserts that, in addition to the fact that the combination of *Brown* and *Nakao* with *Judson* does not teach or even suggest all of the claimed elements, there is no suggestion or motivation to combine these references. Particularly, *Judson*'s invention relates to methods for enhancing the operation of a client browser by displaying information to the user during the period of time between the linking and the downloading a document via the World Wide Web. *Judson*, at Abstract; col. 1, lns. 6-9 and 59-64. Information displayed by *Judson* includes advertisements, notices, messages, and the like. *id.* at col. 2, lns 42-44. Simply put, there is absolutely no reason why a person of ordinary skill in the art would be motivated to combine the web-browsing method of *Judson* with the document management method of *Nakao* and/or the meta editor for structured documents of *Brown*. Nonetheless, the Examiner argues that:

[i]t would have been obvious . . . to combine *Nakao*, *Brown*, and *Judson*, so that the user would have the benefit of viewing the hidden information instantly, without the added time that would have been required to download the information, and [the] information could be viewed as required by the user.

Final Office Action, at p. 13. In response, Appellant asserts that neither *Nakao* nor *Brown* teach or suggest presenting a user with "hidden information," and thus there would be no benefit in "viewing the hidden information instantly" as stated by the Examiner.

Even assuming, *arguendo*, that there would be any benefit in "viewing hidden information instantly" in *Nakao* and/or *Brown*, the Examiner is merely stating that it would be obvious to add *Judson*'s features into *Nakao* and *Brown* in order to have the benefits of *Judson* incorporated into *Nakao* and *Brown*. In other words, the language of the recited motivation is circular in nature, stating that it is obvious to make the modification because it is obvious to achieve the result. Such language is merely a statement that the reference can be modified and

does not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990), *cited in* M.P.E.P. § 2143.01. Neither the prior art nor the knowledge available to a person of ordinary skill in the art suggest the desirability of the combination, and Appellant asserts that there is no suggestion or motivation to combine *Judson* with *Nakao* and/or *Brown*. Accordingly, Appellant respectfully requests that the Board overturn the 35 U.S.C. § 103(a) rejection of record with respect to claim 25.

CONCLUSION

Appellant respectfully asserts that for at least the above reasons claims 1-26 of the present application are patentable over the rejections of record. Accordingly, Appellant respectfully request that the Board overturn these rejections.

Dated: April 13, 2007

Respectfully submitted,

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VIII. CLAIMS APPENDIX

1. A method to restrict editing in a tag-delimited, multi-formatted document comprising:
 - parsing said multi-formatted document;
 - identifying a plurality of tags responsive to said parsing;
 - generating a revised document based on said multi-formatted document;
 - inserting one or more restriction tags into said revised document delimiting non-editable content defined by one or more of said plurality of tags; and
 - restricting edit functions of a page editor editing said revised document, wherein said restricting is responsive to said page editor reading said one or more restriction tags.
2. The method of claim 1 further comprising:
 - compiling a list of document locations containing editable content defined by said one or more of said plurality of tags.
3. The method of claim 1 further comprising:
 - hiding said one or more restriction tags by said page editor, wherein a user of said page editor cannot see said one or more restriction tags during editing.
4. The method of claim 1 further comprising:
 - setting a restriction flag in said revised document to activate edit restriction.
5. The method of claim 4 wherein said restricting step is activated in response to reading said set restriction flag.
6. The method of claim 1 further comprising:
 - presenting a notification to a user of said restricted editing responsive to a user attempting to edit a location delimited by said one or more restriction tags.

7. The method of claim 1 further comprising:
stripping out said one or more restriction tags when said page editor writes said edited multi-formatted document for presentation.

8. A computer program product having a computer readable medium with computer program logic recorded thereon for restricting editing of a multi-formatted document, said computer program product comprising:

code for parsing said multi-formatted document, wherein said each of said multiple formats is delimited in said multi-formatted document by one or more descriptive labels;

code for analyzing said one or more descriptive labels;

code for generating a modified document using content of said multi-formatted document;

code for inserting a prohibition label in said modified document around each instance of non-editable content as defined by said one or more descriptive labels; and

code for prohibiting edit functions of a document editor editing said modified document, wherein said code for prohibiting is executed responsive to said prohibition labels.

9. The computer program product of claim 8 further comprising:
code for assembling a list of editable content locations defined by said one or more descriptive labels.

10. The computer program product of claim 8 further comprising:
code for obscuring said one or more restriction labels by said document editor.

11. The computer program product of claim 8 further comprising:
code for setting a restriction feature flag in said modified document to activate restricted editing.

12. The computer program product of claim 11 wherein said code for prohibiting is activated in response to said set restriction feature flag.

13. The computer program product of claim 8 further comprising:
code for notifying a user of said restricted editing responsive to a user attempting to edit
a location delimited by said one or more descriptive labels.

14. The computer program product of claim 8 further comprising:
code for removing said prohibition tags prior to saving said modified multi-formatted
document for presentation.

15. A method to restrict editing of a Web document comprising:
parsing said Web document;
analyzing a plurality of markup tags within said Web document;
generating a substitute Web document with content of said Web document;
inserting one or more restriction markup tags in said substitute Web document
demarcating non-editable content as defined by one or more of said plurality of markup tags;
and
restricting edit functions of a Web editor editing said substitute Web document,
wherein said restricting is responsive to said one or more restriction markup tags.

16. The method of claim 15 further comprising:
compiling a list of document locations containing editable content defined by said one
or more of said plurality of tags.

17. The method of claim 15 further comprising:
obscuring said one or more restriction markup tags by said Web editor.

18. The method of claim 15 further comprising:
setting a flag in said substitute Web document indicating activation of said restricted
editing.

19. The method of claim 18 wherein said restricting is activated in response to said
flag.

20. The method of claim 15 further comprising:
notifying a user of said restricted editing responsive to said user attempting to access a location demarcated by said one or more restriction markup tags.

21. The method of claim 15 further comprising:
removing said one or more restriction markup tags responsive to a user completing edits.

22. A system for preserving design elements of a Web page during content editing, said system comprising:

a Web development environment comprising:
a parsing engine for analyzing a plurality of Web page markup tags;
a list of restriction tags for insertion around said design elements, as defined by one or more of said plurality of Web page markup tags; and
a page editor comprising:
a plurality of deselectable editing functions, wherein said deselection is responsive to said restriction tags.

23. The system of claim 22 wherein a Web page is processed by said Web development environment to obtain said restriction tags.

24. The system of claim 22 wherein a subject matter expert operates said page editor to perform said content editing.

25. The system of claim 22 wherein said page editor further comprises:
a cover object for obscuring said restriction tags from view in said page editor.

26. The system of claim 22 wherein said Web page includes a restriction switch, accessible by said Web development environment, for activating deselectability of said plurality of deselectable editing functions.

IX. EVIDENCE APPENDIX

No evidence pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 or entered by or relied upon is being submitted.

X. RELATED PROCEEDINGS APPENDIX

No related proceedings or copies of decisions in related proceedings are being submitted.